REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.116, are respectfully requested.

By the foregoing amendment, claims 1-2 and 4-9 have been canceled without prejudice or disclaimer to the subject matter recited therein. Applicants reserve the right to file one or more continuation applications directed to the subject matter recited therein. Additionally, claims 10 and 11 have been amended. Claim 10 has been amended to recite "a composition" in independent form and to recite that the claimed composition "decreases the amount of body fat." Minor changes to the form of claim 11 have been made. Support for the amendments to claims 10 and 11 can be found throughout the originally filed application. Further, new claims 12-18 have been added. Support for new claims 12-18 can be found throughout the present application, including, for instance, original claims 2 and 4-9. Thus, no new matter has been added.

Turning now to the Office Action, the Examiner has presumed "that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made . . . ." OFFICE ACTION at 2. In so stating, the Examiner has also reminded applicants of its obligation "to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made . . . ." *Id.* No specific response is believed necessary to these comments by the Examiner since the subject matter of the various claims was commonly owned at the time the present invention was made.

The Examiner has maintained the rejection of claims 1, 2, 4, 8 and 9 under 35 U.S.C. § 102(b) as allegedly being anticipated by Babayan (U.S. Patent No. 3,450,819). This rejection is respectfully traversed. However, to expedite prosecution in the present application, and not to acquiesce to the Examiner's rejection, claims 1, 2, 4, 8 and 9 have been canceled by the present amendment. Withdrawal of this rejection is thus respectfully requested.

Claims 1, 2 and 4-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Babayan (U.S. Patent No. 3,450,819) in view of Papamandjaris et al. (Life Sciences, 62(14): 1203-15 (1998)). This rejection is respectfully traversed.

As mentioned above, claims 1, 2 and 4-9 have been canceled. Thus, the rejection is rendered moot as to such claims. However, as to claims 10 and 11 (and to the extent that such rejection may apply to new claims 12-18), applicants provide the following arguments.

Neither the Babayan patent nor the Papamandjaris et al. reference (taken alone or in combination) teach or suggest the medium chain triglyceride used in the present invention.

The Examiner has alleged that "one of ordinary skill in the art would expect that the claimed amount of C8 in the 2-position would result from the random interesterification of the fatty acids to the glycerol molecule" since C8 is present in a high amount. OFFICE ACTION at 4. The Examiner has also alleged that one of ordinary skill in the art "would have been able to calculate the ratio of C8 to C10 from claims 8-16 and also be able to calculate the expected amount of C8 in the randomly interesterified triglyceride of Babayan." *Id.* However, Babayan fails to teach or

suggest, as clearly defined in the pending claims, a composition that contains the following three features in combination:

(i) 90% by mass or more of fatty acids constituting medium chain triglycerides are comprised of saturated fatty acids having 8 and 10 carbon atoms,

(ii) the ratio by mass of the saturated fatty acids having 8 carbon atoms to the saturated fatty acids having 10 carbon atoms is 70:30 to 80:20, and

(iii) the saturated fatty acids having 8 carbon atoms is present in an amount of 65 to 80% by mass of the total fatty acids bonded to the triglycerides at the 2-position.

Contrary to the Examiner's allegations, there is no suggestion or motivation to modify the parameters of the Babayan reference to arrive at applicants' claimed invention. The Examiner's comments are simply impermissible hindsight reconstruction. *See, e.g., Sensonics Inc. v. Aerosonic Corp.*, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996) (stating that "[t]o draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made.")

In addition, the Examiner has argued that Example 4 of Babayan "discloses that medium chain fatty acids act to supply energy without depositing added body fat." OFFICE ACTION at 4-5. First, it is noted that the Babayan patent does not specifically demonstrate any data showing the amount of body fat which is allegedly controlled. Second, contrary to the statement in Example 4 of the Babayan patent,

applicants' claimed invention decreases the amount of body fat when the body fat is excessively accumulated, having no effect on the amount of body fat when the amount of body fat is within the proper range, and increasing the amount of body fat when the amount of body fat is insufficient (page 7, lines 16-20). Therefore, the Babayan patent does not teach or suggest the claimed function of applicants' invention.

For all of the reasons described above, a proper *prima facie* case of obviousness has not been established. Even assuming *arguendo* that a *prima facie* case of obviousness exists, the present invention provides unexpected results as set forth in Table I of the present application. Such unexpected results are sufficient to rebut the Examiner's obviousness allegations.

In light of the above, applicants respectfully request that the Examiner withdraw this § 103 rejection.

Lastly, claim 9 continues to be rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over (1) Seiden in view of Babayan, and (2) Menz in view of Babayan. Both of these rejections are respectfully traversed. As discussed above, claim 9 has been canceled without prejudice or disclaimer and therefore these rejections have been rendered moot. The Examiner is thus respectfully requested to withdraw both of these rejections.

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited

In the event that there are any questions relating to this Amendment and Reply, or the application in general, it would be appreciated if the Examiner would

telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

Buchanan Ingersoll PC
Including attorneys from Burns, Doane, Swecker & Mathis

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By: _____
Susan M. Dadio
Registration No. 40,373

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620